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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte FRED A. CUMMINS

Appeal 2014-008861
Application 11/384,593[1]
Technology Center 3600

Before HUBERT C. LORIN, BIBHU R. MOHANTY, and MEREDITH C. PETRAVICK, Administrative Patent Judges.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Fred A. Cummins (Appellant) seeks our review under 35 U.S.C. § 134 of the final rejection of claims 20, 21, and 26–43. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We REVERSE and enter a NEW GROUND OF REJECTION.

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[1] The Appellant identifies Hewlett-Packard Development Company, LP as the real party in interest. App. Br. 4.

THE INVENTION

Claim 20, reproduced below, is illustrative of the subject matter on appeal.

> 20. A computer program product in a non-transitory computer readable media for use in a data processing system for modeling human motivation within an enterprise, the computer program product comprising:
>
> first instructions for structurally monitoring, measuring, and quantifying a level of motivation induced by at least one personal incentive applied towards achievement of a goal in at least a plurality of individuals within the enterprise;
>
> second instructions for structurally monitoring, measuring, and quantifying a level of motivation induced by community values applied towards achievement of a goal in at least a plurality of individuals within the enterprise;
>
> third instructions for structurally monitoring, measuring, and quantifying a level of motivation induced by dependence on supporting goals applied towards achievement of a goal in at least a plurality of individuals within the enterprise;
>
> fourth instructions for structurally monitoring, measuring, and quantifying a level of motivation induced by at least one relationship incentive applied towards achievement of a goal in at least a plurality of individuals within the enterprise; and
>
> fifth instructions for modifying the application of said at least one personal incentive, said at least one relationship incentive, said dependence on supporting goals, and said community values in response to the levels of motivation determined from said structurally monitoring, measuring, and quantifying steps.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Berkson	US 6,049,779	Apr. 11, 2000
Nakagawa	US 6,155,924	Dec. 5, 2000
Sheprow	US 2002/0038251 A1	Mar. 28, 2002
Szynalski	US 2002/0116272 A1	Aug. 22, 2002
Morrison	US 2003/0009367 A1	Jan. 9, 2003
Koller	US 2003/0204424 A1	Oct. 30, 2003
Bangel	US 2006/0184409 A1	Aug. 17, 2006
Cooper	US 2006/0233349 A1	Oct. 19, 2006

The following rejections are before us for review:

1. Claims 20, 21, and 26–43 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.
2. Claims 20, 21, and 26–43 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Koller and Berkson.
3. Claims 27 and 36 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Koller, Berkson, and Nakagawa.
4. Claims 27 and 36 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Koller, Berkson, and Cooper.
5. Claims 27 and 36 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Koller, Berkson, and Bangel.
6. Claims 28 and 37 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Koller, Berkson, and Sheprow.
7. Claims 28 and 37 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Koller, Berkson, and Morrison.

8. Claims 28 and 37 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Koller, Berkson, and Szynalski.

ISSUES

Did the Examiner err in rejecting claims 20, 21, and 26–43 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement?

Did the Examiner err in rejecting claims 20, 21, and 26–43 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Koller and Berkson?

Did the Examiner err in rejecting claims 27 and 36 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Koller, Berkson, and Nakagawa, Cooper, or Bangel?

Did the Examiner err in rejecting claims 28 and 37 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Koller, Berkson, and Sheprow, Morrison, or Szynalski?

ANALYSIS

The rejection of claims 20, 21, and 26–43 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

Regarding claims 20 and 21, the Examiner states that the originally-filed Specification provides "no written description" for the claim limitation "***quantifying a level of motivation*** *induced by at least one personal incentive applied towards achievement of a goal in at least a plurality of individuals within the enterprise...*" Final Act. 3. The Examiner points out

that "Applicant discloses levels of reward/success [0063], level of influence [0085], level of achievement [0102]" and that subjective values of these are used to analyze motivation. (Final Act. 3). "However, at [0096], these values are not tied [to] *a personal incentive applied towards achievement of a goal* as presently claimed in the amendment." Final Act. 4.

The Appellant disagrees, arguing that

> Figure 5 shows that the values of motivation are assigned with respect to a goal where the goals are row-wise defined, incentives are column-wise defined, and motivation values corresponding to a goal and incentive are provided at the intersection of each goal and incentive thereby indicating a quantified level of motivation induced by the incentive towards achievement of the goal. As disclosed in the specification: "[e]ach motivation, the intersection of a goal row 508, 510, and 512 and an incentive column (columns beneath personal incentives 516 and relationship incentives 518), indicates the relevance of the incentive and the influence it has on the goal."

App. Br. 12 (citing to Spec. 28:16–21).

Compliance with the written description requirement is a question of fact. *Ralston Purina Co. v. Far-Mar-Co, Inc.*, 772 F.2d 1570, 1575 (Fed. Cir. 1985). We have reviewed the Specification and find that a preponderance of the evidence weighs in favor of the Appellant's position. In disclosing "[e]ach motivation, the intersection of a goal row 508, 510, and 512 and an incentive column (columns beneath personal incentives 516 and relationship incentives 518), indicates the relevance of the incentive and the influence it has on the goal" (Spec. 28:16–21), the Specification provides adequate written descriptive support for "quantifying a level of motivation induced by at least one personal incentive applied towards achievement of a

goal in at least a plurality of individuals within the enterprise ... " (claims 20 and 21).

The Examiner also states that "the amended features of '***quantifying a level of motivation*** *induced by at least one personal incentive applied towards achievement of a goal in at least a plurality of individuals within the enterprise* ...' . . . is fundamentally different from that disclosed at [0063; 0085; 0093; 0096; 0102]." Final Act. 4. How it is fundamentally different is not explained. However, as the Appellant points out, "[t]he Examiner admitted that the specification teaches that motivations are given values" (App. Br. 12; *see* Final Act. 4 ("Applicant provides an example where motivations are given values from 1 to 5 [0096]."). Accordingly, it appears the Examiner concedes the Specification does indeed provide adequate written descriptive support for "quantifying a level of motivation" as claimed.

The Examiner states that the originally-filed Specification "provides no written description" for various claim limitations in claims 26–29, 33, and 34. Nothing more is said. Given nothing more than conclusory statements, we find a prima facie case of a lack of adequate written descriptive support pursuant to the requirement of, now, § 112(a) has not been made out in the first instance by a preponderance of the evidence.

The rejection of claims 20, 21, and 26–43 are rejected under 35 U.S.C. §103(a) as being unpatentable over Koller and Berkson.

The independent claims are "computer program product" claim 20 and "system" claim 21. Both claims call for "structurally monitoring, measuring, and quantifying a level of motivation induced by at least one

personal incentive applied towards achievement of a goal in at least a plurality of individuals within the enterprise." The Examiner's position is that said claim limitation is disclosed in Koller.

> Koller et al. 2003/0204424 discloses the claimed features as follows: [0030; 0034], a process which provided rewards and incentives for achieving goals based on results of an appraisal where the rewards and incentives vary depending on the goals and may be determined ... [0034], measurable objectives and employee goals and performance are measurable [0011], objective/goal measurements [0016], at the enterprise level goals are set and concrete/measureable initiatives are defined ... how the objective will be reached and what measurement will be used to determine if it was reached ... [0016], means for structurally monitoring and measuring the effect of at least one personal incentive on the achievement of a goal in at least a plurality of individuals within the enterprise (i.e. does the employee meet his objectives to receive a particular salary) [0022; 0030; 0034], linking the attainment of objectives to an employee's salary [0020], measuring objectives, goals, and performance [0011], measuring objectives [0016], monitoring goals [0032], etc ...

Final Act. 19.

However, we agree with the Appellant that "the cited portions of Koller teach, defining goals, providing incentives linked to the goals, and measuring progress towards achievement of a goal" (App. Br. 18), not "monitoring, measuring, and quantifying a level of motivation" as claimed. "Measuring progress towards a goal is different from measuring and quantifying a level of motivation, at least because an individual's level of motivation is different from the goal to be attained by the individual's activity or the progress made towards achieving that goal." App. Br. 19.

We do not find that a prima facie case of obviousness has been made out for the subject matter of claims 20 and 21 in the first instance by a

preponderance of the evidence. We reach the same conclusion for the rejection of claims 26–34 and 35–43 that depend from claims 20 and 21, respectively.

The rejections of claims 27 and 36 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Koller, Berkson, and Nakagawa, Cooper, or Bangel.

The rejections of claims 28 and 37 are rejected under 35 U.S.C. §103(a) as being unpatentable over Koller, Berkson, and Sheprow, Morrison, or Szynalski.

These rejections of claims 27, 28, 36, and 37 which depend from claims 20 and 21, respectively, and whose rejection similarly relies on Koller as disclosing the claim limitation "monitoring, measuring, and quantifying a level of motivation" are not sustained for the reasons discussed above in not sustaining the rejection of claims 20 and 21.

NEW GROUND OF REJECTION

Claims 20, 21, and 26–43 are rejected under 35 U.S.C. § 101 as being directed to judicially-excepted subject matter.

Alice Corporation Party Ltd. v. CLS Bank International, 134 S. Ct. 2347 (2014) identifies a two-step framework for determining whether claimed subject matter is judicially-excepted from patent eligibility under § 101.

According to *Alice* step one, "[w]e must first determine whether the claims at issue are directed to a patent-ineligible concept," such as an abstract idea. *Alice*, 134 S. Ct. at 2355.

Taking claim 20 as representative of the claims on appeal, the claimed subject matter is directed to modeling human motivation. Modeling is a fundamental building block of human ingenuity. As such it is an abstract idea. As for limiting the application of the "modeling" idea to the field of human motivation, this does not render it patentable. "The Court [*Parker v. Flook*, 437 U.S. 584 (1978)] rejected the notion that the recitation of a practical application for the calculation could alone make the invention patentable." *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1371 (Fed. Cir. 2011).

Step two is "a search for an 'inventive concept'—*i.e.*, an element or combination of elements that is 'sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.'" *Id.* (alteration in original) (quoting *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1294 (2012)).

We see nothing in the subject matter claimed that transforms the abstract idea of modeling into an inventive concept.

Claim 20 defines a "computer program product comprising five steps. The first four seek to "structurally monitor[ ], measur[e], and quantify[ ] a level of motivation induced by" (1) "at least one personal incentive," (2) "community values," (3) "dependence on supporting goal," and (4) "at least one relationship incentive," each "applied towards achievement of a goal in at least a plurality of individuals within the enterprise." In "response to the levels of motivation determined from said" first four steps, the fifth steps seeks to modify the (1) "at least one personal incentive," (2) "community

values," (3) "dependence on supporting goal," and (4) "at least one relationship incentive."

None of these individual steps, viewed "both individually and 'as an ordered combination,'" transform the nature of the claim into patent-eligible subject matter. *See Alice*, 134 S. Ct. at 2355 (quoting *Mayo*, 132 S. Ct. at 1297, 1298).

The structurally monitoring, measuring, quantifying, and determining are known operations for gathering and evaluating desired information and thus add little to patentably transform the modeling abstract idea.

Furthermore, each of the monitoring, measuring, quantifying, and determining steps are themselves abstract ideas. For example, regarding "monitoring," *see Wireless Media Innovations, LLC v. Maher Terminals, LLC,* 100 F. Supp. 3d 405 (D.N.J. 2015), aff'd, 636 F. App'x 1014 (Fed. Cir. 2016). Merely combining these abstract ideas does not render the combination any less abstract. *Cf. Shortridge v. Found. Constr. Payroll Serv., LLC*, No. 14-CV-04850-JCS, 2015 WL 1739256 (N.D. Cal. Apr. 14, 2015), *aff'd*, No. 2015-1898, 2016 WL 3742816 (Fed. Cir. July 13, 2016).

Also, the wording of the steps is such that they describe certain objectives sought to be accomplished without providing any of the technical details that may be necessary to accomplish them. For example, the first step is "*for* structurally monitoring, measuring, and quantifying a level of motivation induced by at least one personal incentive applied towards achievement of a goal in at least a plurality of individuals within the enterprise" (claim 21, emphasis added). But this simply aims the instruction toward achieving a result. The desired result is unconnected to how the

"structurally monitoring, measuring, and quantifying" should be performed to achieve it. "Generally, a claim that merely describes an 'effect or result dissociated from any method by which [it] is accomplished' is not directed to patent-eligible subject matter." *Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229 (Fed. Cir. 2016) (quoting *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1348 (Fed. Cir. 2015)).

Finally, we note that claim 20 calls for using the "computer program product in a non-transitory computer readable media for use in a data processing system." But any general-purpose computer available at the time the application was filed would have satisfied these limitations. The Specification supports that view. *See, e.g.*, Spec. 7:6–8:25. "[T]he mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention. Stating an abstract idea "while adding the words 'apply it'" is not enough for patent eligibility." *Alice*, 134 S. Ct. at 2358.

For the foregoing reasons, we find that claim 20 covers claimed subject matter that is judicially-excepted from patent eligibility under § 101. The other independent claim—system claim 21 parallels claim 1—similarly covers claimed subject matter that is judicially-excepted from patent eligibility under § 101. The dependent claims describe various types of information to be gathered or evaluated which do little to patentably transform the abstract idea.

Therefore, we enter a new ground of rejection of claims 20, 21, and 26–43 under 35 U.S.C. § 101.

For the foregoing reasons, the rejections are reversed but the claims are newly rejected under § 101.

CONCLUSIONS

The rejection of claims 20, 21, and 26–43 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement is reversed.

The rejection of claims 20, 21, and 26–43 under 35 U.S.C. § 103(a) as being unpatentable over Koller and Berkson is reversed.

The rejection of claims 27 and 36 under 35 U.S.C. § 103(a) as being unpatentable over Koller, Berkson, and Nakagawa is reversed.

The rejection of claims 27 and 36 under 35 U.S.C. § 103(a) as being unpatentable over Koller, Berkson, and Cooper is reversed.

The rejection of claims 27 and 36 under 35 U.S.C. § 103(a) as being unpatentable over Koller, Berkson, and Bangel is reversed.

The rejection of claims 28 and 37 under 35 U.S.C. § 103(a) as being unpatentable over Koller, Berkson, and Sheprow is reversed.

The rejection of claims 28 and 37 under 35 U.S.C. §103(a) as being unpatentable over Koller, Berkson, and Morrison is reversed.

The rejection of claims 28 and 37 under 35 U.S.C. § 103(a) as being unpatentable over Koller, Berkson, and Szynalski is reversed.

Claims 20, 21, and 26-43 are newly rejected under 35 U.S.C. § 101 as being directed to judicially-excepted subject matter.

DECISION

The decision of the Examiner to reject claims 20, 21, and 26–43 is reversed.

Claims 20, 21, and 26–43 are newly rejected.

NEW GROUND

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review." 37 C.F.R. § 41.50(b) also provides that the Appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

> (1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .
>
> (2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). See 37 C.F.R. § 1.136(a)(1)(iv) (2011).

REVERSED; 37 C.F.R. § 41.50(b)